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09/487,696	01/19/2000	Glenn Petkovsek	USA-P-99-011	3459

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PATENTS+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/30/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,696

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 and 21 is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim has been amended for further examination. Claim 22 has been added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Walz (5,501,393) and further in view of Coats et al.

Main discloses in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forming a transparent compartment to be adhered to a mailpiece (Col. 2, lines 52-59) having an opening (214) wherein the form is capable of entering); a mail form (100, Col. 2, lines 60-67, and Col. 3, lines 1-3) that is removably attached to the backing sheet and further wherein the mailing form is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20); and wherein the mail form has a mailing label section (100), and a non-adhesively attached receipt portion (112).

However, Main does not disclose that the receipt is detachably connected to the mailing label section and further wherein the backing sheet contains an auxiliary label having adhesive.

Walz discloses in Fig. 1-5, a mailing form (12, and section 84) comprised of a non-adhesive receipt (84), wherein the receipt is removably attached to a backing sheet (14) and is detachably connected (through perforated lines, 24 and 26) to the mailing label (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main's mailing form to include a detachably connected receipt

Art Unit: 3722

portion as taught by Walz for the purpose of providing a confirmation notice which can be mailed back to the sender.

However, Main and Walz do not disclose wherein the backing sheet has a third layer having an auxiliary third label.

Coats et al discloses in Fig. 1, a backing sheet (11) forming an envelope compartment wherein a third layer (Col. 5, lines 50-56) being an identification label is disposed on the surface of the backing sheet (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main and Walz's mailing assembly to include a third layer disposed on the backing layer as taught by Coats et al for the purpose of providing an identification mechanism for the mailing assembly.

Allowable Subject Matter

3. Claims 1-16 and 21 are allowed.

Art Unit: 3722

4. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a mailing assembly comprising: a backing sheet which forms an envelope with a compartment that is adhered to a mailpiece; a mailing form that is removably attached to the backing sheet and is subdivided into a plurality of sub-parts, wherein each sub-part is variably printed with information; wherein at least one sub-part is inserted into the compartment; and wherein an adhesive layer is disposed on the backing sheet wherein the envelope formed from the backing sheet is formed via the adhesive layer on the backing sheet; and further wherein a third layer is disposed on the backing sheet having an auxiliary label with adhesive thereon; and including all of the other limitations of the independent claim.

Response to Arguments

5. Applicant's arguments with respect to claims 1-16, 21 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3722

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3722

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 28, 2003



Daniel W. Howell
Primary Examiner
Art Unit 3722